

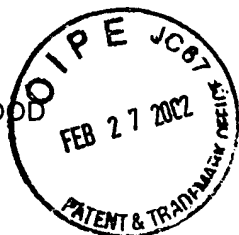


## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/880,138	06/12/2001	James J. Hickman	18805-81106

Nisan A. Steinberg, Esq.  
SIDLEY AUSTIN BROWN & WOOD  
555 West Fifth Street  
Los Angeles, CA 90013



CONFIRMATION NO. 5733

## FORMALITIES LETTER



60200006405048\*

RECEIVED

MAR 08 2002

OFFICE OF PETITIONS

Date Mailed: 08/09/2001

## NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

*Filing Date Granted*

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- Total additional claim fee(s) for this application is \$312.
  - \$72 for 8 total claims over 20.
  - \$240 for 3 independent claims over 3.
- The oath or declaration is missing.  
*A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- **The balance due by applicant is \$ 442.**

*A copy of this notice **MUST** be returned with the reply.*

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

03/06/2002 SMINASS1 00000012 501597 09880138

01 FC:105

130.00 CH



113

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: James J. Hickman, Douglas A. Kirkpatrick, and David A. Stenger  
Serial No. 09/880,138  
Filed: June 12, 2001  
For: Biosensor For Use In Toxicity Assessment and Pharmacological Screening  
Examiner: Unassigned

<b>BOX MISSING PARTS</b> Assistant Commissioner for Patents Washington, D. C. 20231	<b>CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8</b>  I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO BOX MISSING PARTS, ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C., 20231 ON 02/11/02  BY <u>Shirley Dow</u> SHIRLEY DOW February 11, 2002 Date of Signature
---	---

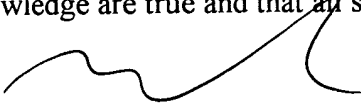
**DECLARATION OF MARK B. MIZRAHI IN SUPPORT OF PETITION TO FILE  
DECLARATION FOR PATENT APPLICATION BY JOINT INVENTOR ON BEHALF  
OF NONSIGNING INVENTORS, AND STATEMENT OF FACTS IN SUPPORT  
THEREOF, UNDER 37 CFR § 1.47(a)**

I, Mark B. Mizrahi, declare:

1. I am an associate with the law firm of Sidley Austin Brown & Wood LLP, acting on behalf of Science Applications International Corporation ("SAIC") in the above-matter.
2. This Declaration is provided in support of SAIC's Petition To File Declaration By Joint Inventor On Behalf Of Nonsigning Inventor Who Refuses to Sign, And Statement Of Facts In Support Thereof, Under 37 CFR § 1.47(a).
3. Prior to the filing of this application, I made various efforts to locate Dr. Stenger, including performing/commissioning an extensive Internet search, wherein it was determined that he was a United States Naval Research Laboratory employee. Soon after having located and contacted Dr. Stenger, by letter dated November 9, 2001 addressed to Dr. Stenger via Certified Mail with return receipt, I provided Dr. Stenger with a true and complete copy of the subject patent application, and the requisite 37 CFR 1.63 inventors' declaration for his execution. (See Exhibit C to the Petition). On or about November 10, 2001, I called Dr. Stenger by telephone, informing him that he should expect to receive the materials via Certified Mail. Dr. Stenger stated that he would review the materials and would promptly respond. Not having heard back from Dr. Stenger, on December 3, 2001, I left a voicemail for Dr. Stenger inquiring into the status of the paperwork. Dr. Stenger responded the following morning by telephone, stating that he had not received the November 9, 2001 letter and enclosures and asked that they be re-sent.

4. On December 4, 2001, I re-sent the November 9, 2001 letter and enclosures to Dr. Stenger, this time via Federal Express. (See Exhibit E to Petition). Via teleconference on December 20, 2001, Dr. Stenger informed me that he declines to participate in the prosecution of the application. Later that same day, Dr. Stenger confirmed this in writing and specifically declined to execute the 37 CFR 1.63 Inventors Declaration. (See Exhibit F to Petition).

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statement may jeopardize the validity of this application or any patent issued thereon, declares that all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true.

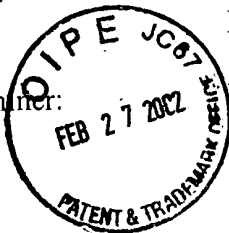
  
\_\_\_\_\_  
Signature

Mark B. MIZRAHI  
\_\_\_\_\_  
Typed or Printed Name

2/11/02  
\_\_\_\_\_  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: James J. Hickman, Douglas A. Kirkpatrick and David A. Stenger  
 Serial No. 09/880,138  
 Filed: June 12, 2001  
 For: BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND  
 PHARMACOLOGICAL SCREENING  
 Examiner: Unassigned Group Art Unit: 1636

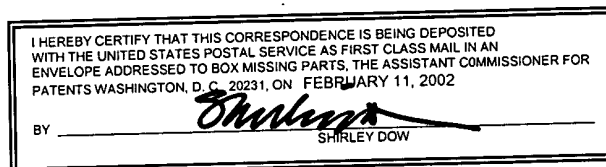


DAC  
 sector  
 ✓ #

**TRANSMITTAL OF AND RESPONSE TO  
 NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION  
 FILED UNDER 37 CFR 1.53(b) FILING DATE GRANTED**

RECEIVED  
 MAR 08 2002  
 OFFICE OF PETITIONS

BOX MISSING PARTS  
 Assistant Commissioner for Patents  
 Washington, D. C. 20231



Dear Sir or Madam:

In response to the *Notice to File Missing Parts of Nonprovisional Application Filing Date Granted* mailed August 9, 2001, Applicant submits the following documents:

1. Copy of *Notice to File Missing Parts of Application (Part 2)*;
2. Petition for Extension of Time Under 37 CFR 1.236(a), for which there is a fee of \$1,440.00;
3. Fully executed Declarations of inventors James J. Hickman and Douglas A. Kirkpatrick;
4. Petition to File Declaration for Patent Application By Joint Inventor on Behalf of Nonsigning Inventor Who Refuses To Sign, and Statement of Facts In Support Thereof, Under 37 CFR § 1.47(a), for which there is a fee of \$130.00; and
5. Request for Correction of Filing Receipt.

04/01/2002 AKELLEY 00000021 501597 09880138  
 01 FC:122 130.00 CH

The Commissioner is hereby authorized to charge \$1,570.00 under 37 C.F.R. §§ 1.16(e) and 1.17 which may be required, or to credit any overpayment, to Deposit Account No. 50-1597.

Respectfully submitted,

By: Edward G. Poplawski  
Edward G. Poplawski  
Registration No. 33,439

SIDLEY AUSTIN BROWN & WOOD LLP  
555 West Fifth Street  
Los Angeles, California 90013-1010  
Ofc: 213-896-6601  
Fax: 213-896-6600